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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/724,706

12/02/2003

Yoshihisa Tsukada

1982-0208P

1979

2292 7590 09/23/2008
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EXAMINER

CHEA, THORL

ART UNIT

PAPER NUMBER

1795

NOTIFICATION DATE

DELIVERY MODE

09/23/2008

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/724,706	Applicant(s) TSUKADA ET AL.	
	Examiner Thorl Chea	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is responsive to the communication on August 20, 2008; claims 1-18 are pending in this instant application.
2. The finality of the Office Action on February 20, 2008 is withdrawn in view of the petition decision granted on September 17, 2008, and the reason set forth below.

Priority

3. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 of the US Application 09/953,958, filed September 18, 2001, and JP2000-281809 filed September 18, 2000 as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/953,958, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. In this case, the US Application serial No. Application 09/953,958, filed September 18, 2001, and JP2000-281809 filed September 18, 2000 fails to disclose one or more claims of the invention claimed in the present US Patent

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Application Serial No. 10/724,706. The disclosure of the US Patent Application serial No. 09/953,958 fails to provide support for the “binder comprise a polymer formed by copolymerization of monomers including 10 to 70 % by mass of the monomer represented by the following formula (M): $\text{CH}_2=\text{CR}^{01}-\text{CR}^{02}=\text{CH}_2$ wherein R^{10} represents a hydrogen atom, an alkyl group having 1 to 6 carbon atom or a halogen atoms; R^{02} represents an alkyl group having 1 to 6 carbon atoms or a halogen atom; wherein R^{01} and R^{02} are never both simultaneously a hydrogen atom” . The prior filed application fails discloses the mass of 10 to 70 % of the monomer, and the conditions set for R^{01} and R^{02} claimed in the present claimed invention. The copending application considered as a whole is related to a polymer contains a recurring unit represented by formula (1). See page 5 of the prior patent application. The conjugated dienes: e.g. “1,3-butadiene, isoprene, 1,3-pentadiene, 2-ethyl-1,3-butadiene, 2-n-propyl-1,3-butadiene, 2,3-dimethyl-1,3-butadiene, 2-methyl-1,3-butadiene, 1-phenyl-1,3-butadiene, 1-naphthyl-1,3-butadiene, 1-~naphthyl-1,3-butadiene, 2-chloro-1,3-butadiene, 1-bromo-1,3-butadiene, 1-chloro-1,3-butadiene, 2-fluoro-1,3-butadiene, 2,3-dichloro-1,3-butadiene, 1,1,2-trichloro-1,3-butadiene, 2-cyano-1,3-butadiene and cyclopentadiene” are disclosed on pages 15-15. However, the prior filed application fails to fully support the monomer of the formula (M). The disclosure of the prior filed application fails to provide support for the claimed invention, and therefore, the present patent application fails to obtain the benefit of the priority date of the prior filed application serial no. 09/953,958.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-18 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsukada et al (US 2002/0058220 A1).

See Tsukada as a whole, especially the polymer on page 7, (P-15) wherein y in P-14 is 33, and T_g is 7 °C and z is 5; page 38 wherein the polymer is incorporated in the image forming layer; the polyhalogenate compound on page 19, formula (5) and pages 20-22 formula (5-1) to (5-40); the amount of organic polyhalogen compound on page 22, [0126]; and the binder has glass transition temperature T_g from –20 °C to 80 °C on page 5, [0045].

Tsukada et al discloses the polymer of formula 15 within the scope of the polymer claimed in the present claimed invention. Therefore, the invention as claimed lacks novelty. Alternatively, it would have been obvious to the worker of ordinary skill in the art at the time the invention was made to use the polymer disclosed in Tsukada et al with an expectation of achieving a material having an improved coated surface structure and improved stability to image formation.

Response to Arguments

7. Applicant's arguments filed June 19, 2008 have been fully considered but they are not persuasive. The applicants argue that : “Applicants respectfully refer the Examiner to the claim for priority to Tsukada *et al.* '220 (which is Application Serial No. 09/953,958) and the *renewed*

Petition under 37 C.F.R. § 1.78(a)(3) that was previously filed on April 7, 2008. It is believed that the defects of the first Petition have been resolved. Also, the Petitions branch at the USPTO indicated that a decision on the renewed Petition will be issuing soon”.

The petition to accept an intentionally delayed claim for priority under 37 C.F.R. 1.78(a)(3) has been granted on September 17, 2008. However, the granting of the petition is not necessarily meant that the presently filed application gets the benefit of the priority filing date of the prior filed application. The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/953,958 , fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. See the discussion with respect to the compliance of the requirements of the first paragraph under 35 USC 112, first paragraph above.

The rejection of claims 1-18 under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Tsukada et al (US 2002/0058220 A1) is maintained for the reason set forth above. The presently filed application gets the benefit of the priority filing date of the prior filed application (09/953,958) for the reason disclosed in paragraph 3 above.

Conclusion

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (571) 272-1328. The examiner can normally be reached on 9 AM-5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on (571)272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TC
2008-02-09

/Thorl Chea/
Primary Examiner,
Art Unit 1795